



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,098	03/31/2004	Odile Aubrun-Sonneville	238275US0	5536
22850	7590	07/29/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ZAREK, PAUL E	
			ART UNIT 1617	PAPER NUMBER
			NOTIFICATION DATE 07/29/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary**Application No.**

10/813,098

Applicant(s)

AUBRUN-SONNEVILLE ET AL.

Examiner

Paul Zarek

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Please note that the Examiner examining the instant application has changed. Applicants are invited to direct any questions or concerns to Paul Zarek (contact information below).

Status of the Claims

2. Claims 1 and 3 have been amended by the Applicant in correspondence filed on 12/15/2008. Claims 1-17 are currently pending. This is the third Office Action on the merits of the claim(s).

RESPONSE TO ARGUMENTS

3. Claims 1-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Morchhäuser, et al. (European Patent no. 1 069 142, issued 2001, US Patent No. 6,645,476 used as English equivalent), in view of Hoeffkes, et al. (US Patent no. 4,919,923, issued 1990). Applicants traversed this rejection on the grounds of unexpected results as demonstrated in the Declaration under 37 C.F.R. § 1.132 wherein Dr. L'Alloret compares instantly disclosed Example 5 and the composition disclosed by Morchhäuser, et al. Applicants further contend that the claims have been amended to be more closely aligned with the data presented in the instant specification and the L'Alloret Declaration. Thus, Applicants assert that the rejection under 35 U.S.C. §103(a) no longer applies. Examiner respectfully disagrees.
4. Amended Claim 1 recites the limitation that “n and p, independently of each other, denote an integer ranging from 7 to 24 with the proviso that $n + p$ is less than 25.” Such an amendment

requires the presence of propylene oxide ($-\text{CH}_2\text{CH}(\text{CH}_3)\text{O}-$) subunits. The L'Alloret Declaration utilizes Genapol® LA-070 methacrylate, which the instant specification indicates as a "C₁₂-C₁₄ alcohol oxynethylenated with 7 mol of ethylene oxide" (pg 11, lines 14-16). This compound lacks the propylene oxide group required by the amended claims. Examiner further notes that all of the working examples disclosed in the instant application utilize either Genapol® LA-070 methacrylate or Genapol® T-080 methacrylate, which also lacks the propylene oxide group. Thus, all of the disclosed examples are currently outside the scope of the amend claims. Moreover, all of the examples utilize both beeswax or palm oil wax and a significant amount of parlean oil (by weight percentage). The instantly recited claims broadly recite wax and do not recite parlean oil. It is unclear from both the instant specification and the L'Alloret Declaration how beeswax (or palm oil wax) and parlean oil contribute to the stability of the composition. Applicants have demonstrated the stabilizing effect with regards to only beeswax and palm oil wax. Other waxes would be expected to have different solubility and stability profiles (for example silicone waxes would have an increase silophilicity and fluorinated waxes would be expected to have increased fluorophilicity) and thus would be expected to have different interactions with parlean oil. It is applicant's burden to demonstrate unexpected results over the prior art. See MPEP §§ 716.02, and 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance (*Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992)). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA

1972). Since the showing is not commensurate with the scope of the subject matter claimed, the L'Alloret Declaration has not sufficiently demonstrated unexpected results.

5. Hoeffkes, et al., was utilized to demonstrate the advantageous properties of various waxes, including beeswax, in oil-in-water emulsions. Applicants have not disagreed with Hoeffkes, et al., in the capacity in which it was used. Therefore, the rejection of Claims 1-17 under 35 U.S.C. 103(a) as being unpatentable over Morchhäuser, et al., in view of Hoeffkes, et al., is maintained.

6. Claims 1-17 were rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 22-27, and 29-49 of U.S. Patent No. 6,905,674 B2 in view of Hoeffkes, et al. (above). Applicants traversed this rejection for the same reasons discussed with respect to Morchhäuser, et al., and Hoeffkes, et al. Since Applicants have not sufficiently demonstrated unexpected results with respect to Morchhäuser, et al., Applicants have likewise, not sufficiently differentiated the instant application from the '674 patent. Therefore, the rejection of Claims 1-17 on the grounds of nonstatutory obviousness-type double patenting over claims 1-5, 22-27, and 29-49 of U.S. Patent No. 6,905,674, in view of Hoffkes, et al., is maintained.

7. Claims 1-10 and 12-17 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/813,013. This rejection is withdrawn in light of Applicants' amendments to Claim 1 and the amendments to the claims of the copending '013 patent application.

Conclusion

8. Applicants' amendment to the claims do not overcome the standing rejections. Claims 1-17 remain rejected.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Zarek whose telephone number is (571) 270-5754. The examiner can normally be reached on Monday-Thursday, 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PEZ

/San-ming Hui/
Primary Examiner, Art Unit 1617